

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on February 11, 2008, claims 94, 95, 100-108, 110, 114-116 and 118 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kravetz et al. (United States Patent No. 6,397,196, hereinafter “Kravetz”), claim 96 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravetz in view of Official Notice, claims 99 and 113 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravetz in view of Risafi et al (United States Patent No. 6,473,500, hereinafter “Risafi”), and claim 117 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kravetz in further view of an article by Rusty Cawley (“New Texas Capital product marries payroll, ATMs”, hereinafter “Cawley”). Accordingly, Applicant respectfully submits the following:

Claims 119-150 are new.

### Rejections under 35 U.S.C. 102

In the Office Action, claims 94, 95, 100-108, 110, 114-116, and 118 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kravetz. Applicant respectfully submits that the claim set as provided herein is not anticipated by the cited references. M.P.E.P. § 2131 sets forth the standard for a rejection of a claim as anticipated under 35 U.S.C. § 102. “To anticipate a claim, the reference must teach every element of the claim.” M.P.E.P. § 2131 states further,

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that Kravetz does not teach every aspect of the claim set as provided herein and therefore does not anticipate the claims, for at least the following reasons.

As previously discussed in Applicant’s most recent prior response, Kravetz does not

explicitly or impliedly teach every aspect of the claimed invention. For example, Kravetz does not explicitly or impliedly teach “receiving an electronic request for said payroll access against wages of said employee, … wherein said wages have been earned by said employee but not yet paid to said employee by said employer”. Instead, Kravetz teaches of a hybrid installment loan/savings account wherein automatic payroll deduction is applied to pay off the loan and continues even after the loan is paid in full. (col. 1, lines 55-59) In this manner, Kravetz teaches that a customer can use automatic payroll deduction to pay off the loan amount and then continue the automatic payroll deduction to accrue savings while earning interest. (col. 1, lines 61-64)

Regarding this argument by Applicant, Applicant notes that in the Response to Arguments provided on pages 9-10 of the Office Action, Applicant’s arguments have been indicated as not being persuasive. Specifically, regarding Appellant’s contentions, the Examiner indicated:

The examiner notes under the broadest reasonable interpretation Kravetz teaches “receiving an electronic request for said payroll access against wages of said employee… wherein said wages have been earned by said employee but not yet paid to said employee by said employer” (Kravetz, see at least, Col. 4, lines 5-12 and lines 38-40; FIG. 2). The examiner notes that automatic payroll deduction will take place as long as the employee is employed by the employee’s employer. An electronic request is made via an ATM network for said wage (e.g. withdrawal for money) at any given time. The examiner notes even though the request for withdrawal are directed to a hybrid loan/savings account it is taken from the employee’s wages. This is the purpose of the direct deposit for the employee’s wages. In essence the hybrid loan/savings is needed as a security basis for the bank in case of legal action. The teachings of Kravetz are for wages being deducted from an employee, based on the income of the wages. The examiner notes this argument is not persuasive.

(Office Action, paragraph spanning pages 9-10)

Regarding these statements in the Office Action, Appellant first notes that while the Examiner purports to use the “broadest reasonable interpretation” of the claim language in rejecting the claims, the Office Action fails to indicate what that supposed broadest reasonable

interpretation is. In this way, Applicant has been deprived of an adequate opportunity to address the position of the Office Action, other than to respectfully disagree with the rejections. Appellant also wishes to note that the standard of interpretation utilized in the Office Action is not the correct standard. The M.P.E.P. and case law are abundantly clear that the correct standard for interpreting claim terms is not merely the “broadest reasonable interpretation,” but should be the “broadest reasonable interpretation consistent with the specification” and should be an interpretation “consistent with the interpretation that those skilled in the art would reach.” See M.P.E.P. § 2111. This standard has been set forth and repeatedly applied by the Federal Circuit:

Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art . . ..”); *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (“It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, . . . and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.”) (emphasis added); see also M.P.E.P. § 2111.01 (“[T]he words of a claim . . . must be read as they would be interpreted by those of ordinary skill in the art.”). Prior art references may be “indicative of what all those skilled in the art generally believe a certain term means . . . [and] can often help to demonstrate how a disputed term is used by those skilled in the art.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584, 39 USPQ2d 1573, 1578-79 (Fed. Cir. 1996).

*In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (emphasis in original). Whatever the interpretation being used in the Office Action, there is absolutely no showing that the interpretation is consistent with the specification or consistent with the interpretation that those skilled in the art would reach.

Appellant respectfully submits that the rejections set forth in the Office Action apparently rely on a definition of the claim language that lacks any factual finding or support, is inconsistent with the specification, and is inconsistent with the interpretation that would be given the claim

language by one of skill in the art in light of the specification. Therefore, the rejections should be removed and the application allowed over the art of record.

The application as filed is replete with instances that give light and meaning to the disputed claim language of "receiving an electronic request for said payroll access against wages of said employee... wherein said wages have been earned by said employee but not yet paid to said employee by said employer." For example, reference may be made to the following passages from the specification as filed (where appropriate emphasis has been added):

It is yet an additional object of one embodiment of the present invention to allow an employee access to wages and pay already earned.

Page 5 lines 13-14.

If desired, in one presently preferred embodiment, the amount of funds accessible to the employee may be limited to a predetermined amount. The amount to which the employee is limited may be based, for example, upon a number of factors, such as . . . the number of days worked for a given pay period and other relevant factors.

Page 8 line 18-page 9 line 3. (See also page 16 lines 8-9.)

Typically, the ATM card is tied to some monetary limits, such as salary earned based on actual hours worked to date for the pay period, the employee has access to salary or pay as he or she desires. This employee could access payroll daily, weekly, bi-weekly, etc. On the day when the employee would otherwise receive a paycheck or pay stub, the employee receives a settlement, stub, or pay showing the amounts of pay already accessed along with the check or other payment he would normally receive.

For example, John Smith works 16 hours. In two days at \$10 per hour, he has approximately \$160 in gross wages. He is allowed to access up to seventy-five percent of that amount using the present invention, or \$120. A week later he has 40 hours total work for the pay period, and having accessed 16 hours of previous pay, he has 24 hours of pay available, of which he can access seventy-five percent. Again, that money can be accessed as needed on a daily or weekly basis.

In one embodiment, the hours worked by an employee and the correlating daily wages earned are tracked and stored electronically. Information is updated daily giving a running total of the employee's wages earned for a given pay period. This information is included in the payroll access system of the present invention. The information can be utilized by the parties involved in setting limits on

withdrawals from the payroll, such as allowing a payroll access withdrawal based on the hours worked to date

Page 22 line 8-page 23 line 6

Applicant respectfully submits that in light of such language, it is impossible to say that under the broadest reasonable interpretation of the disputed claim language in light of the specification and as it would be understood by one of skill in the art, that any portion of Kravetz teaches the disputed recited claim language. Specifically, reference may be made to the portions of Kravetz cited in the Office Action, which provide:

As indicated in FIG. 1, automatic payroll deduction is initiated to pay off the loan balance. However, in the present invention, the automatic payroll deduction does not stop after the balance is paid in full. Instead, the automatic payroll deduction continues so that savings is accrued in the account. As a result, when the balance is negative, interest can be charged to the account. When the balance is positive, interest can be paid to the account.

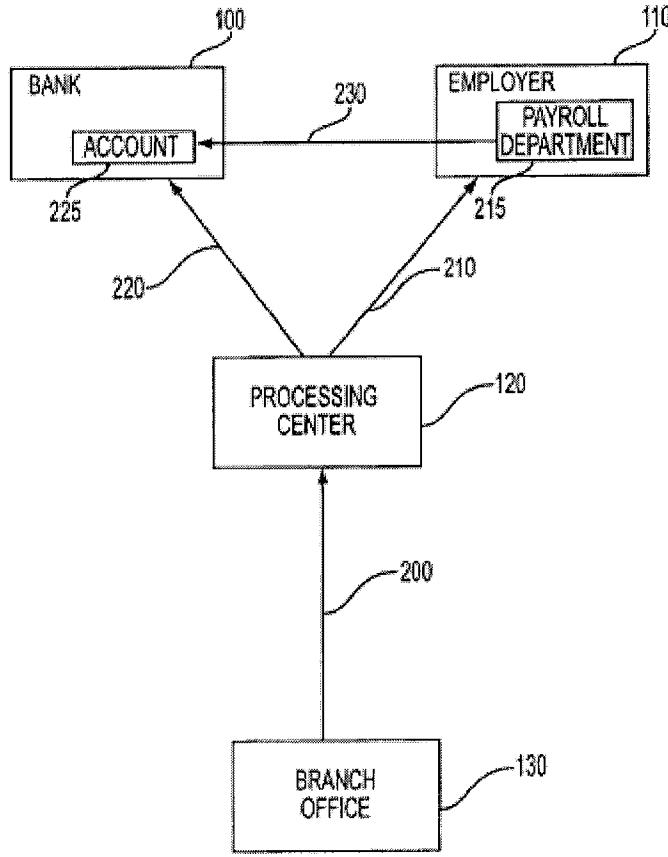
Column 4 lines 5-12, emphasis added.

In addition, the account holder might be provided with the ability to make withdrawals and deposits through an ATM network.

Column 4 lines 38-40.

As may be seen from the portions of Kravetz that have been cited against the claim language, Kravetz teaches making a loan to an individual and instituting an automatic payroll deduction to eventually pay off the loan. Nothing in the cited portions (or anywhere else in Kravetz) teaches anything regarding wages that have been earned by the employee but not yet paid to the employee by the employer. Therefore, Applicant respectfully disagrees with the position taken in the Office Action.

Applicant also notes that the Office Action cites to Figure 2 in the rejection of the recited claim language and in the response to arguments on pages 9-10. Therefore, for convenience of reference, a copy of Figure 2 is provided below:



**FIG. 2**

wages already earned but not yet paid to the employee. Therefore, nothing that would anticipate the recited claim language has been shown by reliance on Figure 2.

Therefore, the statement in the Office Action that the claim language “receiving an electronic request for said payroll access against wages of said employee... wherein said wages have been earned by said employee but not yet paid to said employee by said employer” is anticipated without any analysis of what the broadest reasonable interpretation of the analyzed claim language is, and further without any analysis of whether the supposed interpretation is consistent with the specification and the interpretation that would be drawn by one of skill in the art, is clearly erroneous. As Kravetz clearly does not teach all recited claim limitations, the rejections relying thereon should be removed.

As may be seen from Figure 2, nothing is shown regarding wages already earned by the employee but not yet paid to the employee. Indeed, Kravetz discloses that Figure 2 is a diagram illustrating an organizational structure for implementing the disclosed hybrid installment loan/savings account, thereby illustrating the various parties involved in the account, including a bank, an employer, a processing center, and a branch office. (See Col 4 line 63-Col 5 line 2.) As may be seen, nothing in Figure 2 discloses any

For at least these reasons, Applicant respectfully submits that Kravetz does not explicitly or impliedly teach every aspect of the invention as claimed in the independent base claims. In addition, the dependent claims place further limitations on otherwise allowable subject matter. Accordingly, Applicant respectfully submits that the cited reference does not teach every aspect of the claims as provided herein and therefore does not anticipate the claims as provided herein.

Accordingly, for at least these reasons, rejection of the claims under 35 U.S.C. § 102 is respectfully requested to be withdrawn.

Rejections under 35 U.S.C. 103

In the Office Action, claim 96 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravetz in view of Official Notice, claims 99 and 113 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kravetz in view of Risafi, and claim 117 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kravetz in further view of Cawley. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for

example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.)

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. In particular, as discussed in detail above, Kravetz does not teach all limitations of the various independent claims, which are included in the rejected dependent claims by dependency. No showing has been made that any of the other cited references teach such limitations. For at least this reason, Applicant respectfully submits that the references cited in the Office Action, alone or in combination, do not teach or suggest all the claim limitations of the independent base claims. And, since the references cited in the Office Action do not teach or suggest each and every limitation of the independent claims, Applicant respectfully submits that the prior art references do not make obvious the independent claims as provided herein. And since the prior art references do not make obvious the independent claims, Applicant respectfully submits that the prior art references cited in the Office Action do not make obvious the corresponding dependent claims, which depend from the independent base claims.

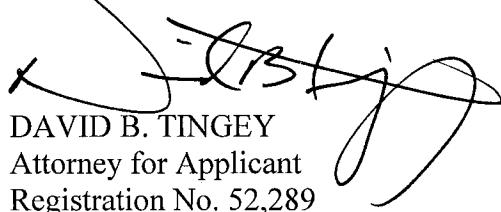
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein overcomes all rejections made in the Office Action.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 12<sup>th</sup> day of May, 2008.

Respectfully submitted,

  
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